



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/688,849	10/15/2003	Mark Munson	ARR001 CIP	9448

37802 7590 08/03/2006

HOGAN & HARTSON LLP  
ONE TABOR CENTER  
1200 17TH STREET, SUITE 1500  
DENVER, CO 80202

EXAMINER
----------

FREISTEIN, ANDREW B

ART UNIT	PAPER NUMBER
----------	--------------

1626

DATE MAILED: 08/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/688,849

Applicant(s)

MUNSON ET AL.

Examiner

Andrew B. Freistein

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 10 and 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 12-14 is/are rejected.
- 7) ☒ Claim(s) 1-9 and 12-14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/6/04</u> . | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

The amendment filed 05/04/2006 has been entered. Claims 1-14 are pending.

***Priority***

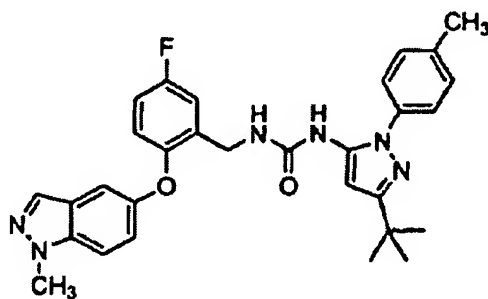
This application is a CIP of US application no. 10/378,164, filed 03/03/2003.

***Information Disclosure Statement***

Applicant's information disclosure statement (IDS), filed on 02/06/2004, has been considered. Please refer to Applicant's copies of the 1449 submitted herewith.

***Restriction Requirement***

In a response filed 05/04/2006, Applicant elected (without traverse) Group I, claims 1-9 and newly added claims 12-14. Further, Applicant elected the species of



Example 94,

In the response, Applicant elected his own group. However, this group is contains too many patentably distinct compounds and Examiner further restricts the compounds of claim 1 in the following manner:

***Status of the Claims***

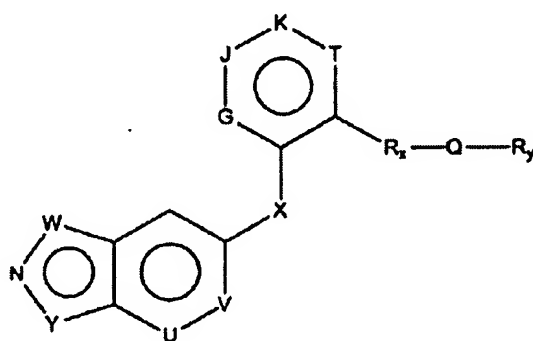
Claims 1-9 and 12-14 (in part) are withdrawn from further consideration by the Examiner as being drawn to non-elected inventions under 37 CFR § 1.142(b). The withdrawn subject matter is patentably distinct from the elected subject matter as it

Art Unit: 1626

differs in structure and element and would require separate search considerations. In addition, a reference that anticipates one invention would not render obvious the other invention.

### Elected and Examined Subject Matter

The scope of the invention of the elected subject matter and the examined subject matter is as follows:



Compounds of the Formula

, wherein:

Y, W, U, V,  $R^2$  and  $R^3$  are each as defined in claim 1;

X is O, S, SO or  $SO_2$ ;

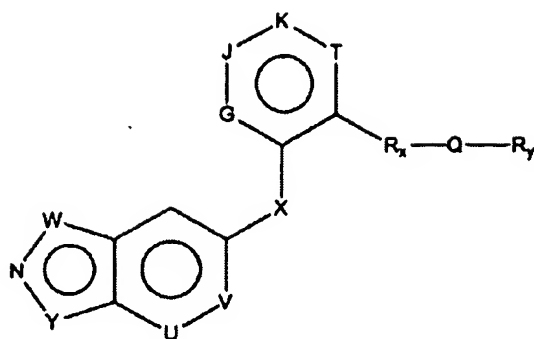
G, J, K and T are each  $CR^z$ ;

$R^z$  is as defined in claim 1; and

$R_x$ , Q and  $R_y$  are as defined in claim 1.

### Non-elected and Non-examined Subject Matter

The scope of the invention of the non-elected and non-examined subject matter is as follows:



Compounds of the Formula

, wherein:

X is NR<sup>5</sup>, C=O, CH<sub>2</sub>, CH<sub>2</sub>Z<sub>n</sub>-OH, or C=NOR<sup>d</sup>; and

G, J, K and T are independently N.

As a result of the election and the corresponding scope of the invention, identified supra, the remaining subject matter of Claims 1-9 and 12-14 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to non-elected inventions. The withdrawn compounds contain varying functional groups, which are chemically recognized to differ in structure, function, and reactivity.

Therefore, the subject matter which was withdrawn from consideration as being non-elected subject matter materially differs in structure and composition from the elected/examined subject matter so that a reference which anticipates the elected/examined subject matter would not render obvious the non-elected subject matter.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140

Art Unit: 1626

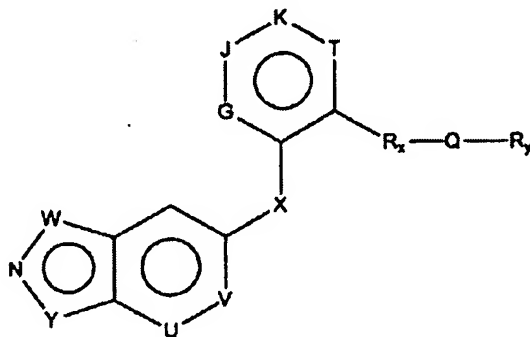
F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-9 and 12-14 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 27-35 of copending Application No. 10/788,044. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

The instant application is drawn to a compound and composition comprising a



compound of the formula

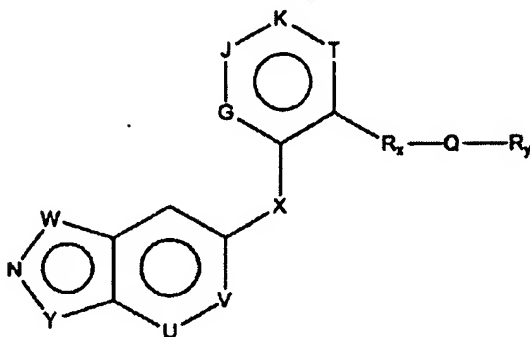
for the treatment of p-

38-mediated conditions.

Art Unit: 1626

Determining the Scope and Content of the Copending Application

The copending application is drawn to a compound and composition comprising



a compound of the formula

for the treatment of p-

38-mediated conditions.

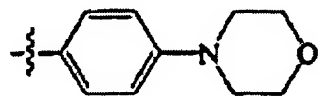
Ascertaining the Differences Between the Instant Application and the Copending Application

The amendment to the instant application filed 5/4/06 amended the variable Y to be NR<sup>2</sup> and W to be CR<sup>3</sup>; U to be CR<sup>c</sup>, V to be CR<sup>c</sup>, and variable H to become variable K. The copending application does not contain these amendments.

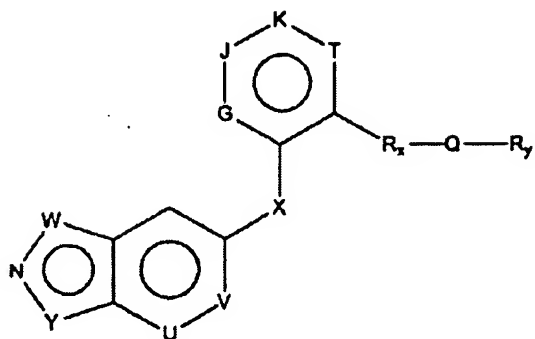
Finding Prima Facie Obviousness

Absent the amendment filed 5/4/06, the instant claims and the copending application are exactly the same. One of ordinary skill in the art would be motivated to produce the compounds of the instant application with the disclosure of the prior art. For example, claim 6 of the instant application is drawn to

**The compound of claim 6, wherein R<sub>y</sub> isopropyl or**

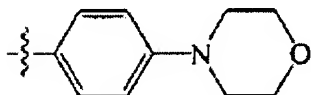


Similarly, claim 32 of the copending application (the 6<sup>th</sup> claim of the formula



) is drawn to:

The compound of claim 31, wherein  $R_y$  isopropyl or



. Thus, one

of ordinary skill in the art would be motivated to produce the compounds of the instant application for the same use as the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Objections***

Claims 1-9 and 12-14 are objected to as being drawn to non-elected subject matter.

### ***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew B. Freistein whose telephone number is (571) 272-8515. The examiner can normally be reached Monday-Friday, 8:30 am - 5:00 pm.

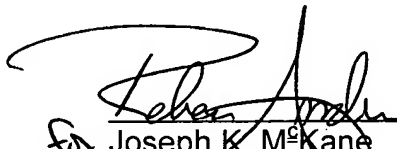
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph M<sup>c</sup>Kane can be reached on (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.



Art Unit: 1626

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

Andrew B. Freistein  
Patent Examiner, AU 1626



Joseph K. McKane  
Supervisory Patent Examiner, AU 1626  
Date: August 1, 2006